

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-20 are pending in this application.

The outstanding Office Action includes a rejection of Claims 7 and 8 under 35 U.S.C. § 102(e) is being anticipated by Adar et al. (U.S. Patent No. 6,493,702, Adar) and a rejection of Claims 1-6 and 9-20 as being unpatentable over Adar in view of Gottsman et al. (U.S. Patent No. 6,134,548, Gottsman).

REQUEST FOR WITHDRAWAL OF INCOMPLETE OFFICE ACTION

The outstanding Office Action rejection of Claims 7 and 8 under 35 U.S.C. § 102(e) is being anticipated by Adar is clearly repeated from the last Office Action.

MPEP §707.07(f) notes that “an examiner must provide clear explanation of all actions taken by the examiner during prosecution of an application” and notes that when a traverse of such a previously made and repeated rejection has been filed, the examiner’s job is to “take note of the applicant’s argument and **ANSWER THE SUBSTANCE OF IT** [emphasis added].”

Instead of following the directions present in MPEP §707.07(f) that require the substance of the arguments already made as to this rejection be answered, the outstanding Action dismisses these arguments and those pointing out other improper manipulations of the teachings of Adar as being “moot in view of the new ground(s) of rejection” at the bottom of page 13 of the outstanding Action.

Accordingly, as the outstanding Office Action rejection of Claims 7 and 8 under 35 U.S.C. § 102(e) is being anticipated by Adar is clearly repeated from the last Office Action

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and is not a new ground of rejection as alleged, the present improper Office Action should be withdrawn and replaced with one that properly answers the arguments already made as to this rejection.

REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.116

With respect to the rejection of Claims 7 and 8 under 35 U.S.C. § 102(e) as being anticipated by Adar, page 17 of the last response noted that anticipation could not be present absent the relied upon Adar reference showing each claimed element exactly in the arrangement claimed as follows:

It is well established that in order for anticipation to exist, a single prior art reference must not only disclose each and every element being claimed, these elements must be disclosed to be present in the claimed arrangement. See In re Bond, 15 USPQ 2d 1566 (Fed. Cir. 1990); Lindemann Maschinen Fabrik GMBH v. American Hoist & Derrick Co., 221 USPQ 481 (Fed. Cir. 1984); and Ex parte Gould, 6 USPQ 2d 1680 (Bd. Pat. App. & Int. 1987). As fully explained in Ex parte Osmond, 191 USPQ 334, 336 (Bd. Pat. App. & Int. 1973), there must be something in a patent disclosure which would direct a person of ordinary skill in the art to make the selections necessary to bring together the separate elements to form the combination being relied upon. As no such teaching is present here, the reliance upon Adar as anticipating Claims 7 and 8 is clearly improper.

If a reference shows only isolated pieces as separate disclosures, as Adar is relied upon in the outstanding Action does, then, as noted in Osmond, the question is where can the motivation be found to make the selections necessary to bring together the separate elements to form the combination being relied upon. See In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) as follows:

Further, a rejection cannot be predicated on the mere identification in [a single reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

As was further stated at pages 15-17 of the last response, this mere identification of isolated parts of Adar is clear as is the lack of any suggestion in Adar to bring these various isolated disclosures together. These statements are repeated here for the examiner's convenience as follows:

Turning to Claim 7, it is noted that page 5 of the outstanding Office Action appears to pick unrelated isolated disclosures from Adar and then seeks to combine them as if they were taught by the reference to be combinable. Note, for example, the rationale begins by referencing column 24, lines 35-44 which is part of Claim 59 of Adar directed to an information repository search engine. Here, the Office Action suggests that the event that has taken place can be read on receiving "at least a key word query." Instead of staying with Claim 59 and correlating the terms therein to the remainder of Claims 7 and 8, the Office Action then turns to column 12, lines 48-59 as to the step of extracting attribute information from an existing text file. In this regard, it appears that the search key words feature described here is being relied on. However, Claim 7 and Claim 8 both include a separate step of "selecting an important word from among words contained in said existing text file." It appears from the rationale presented in page 5 that the two separate "extracting" and "selecting" steps are being improperly conglomerated together so that the "extracting" of the attribute information from the existing text file is being read to exactly correspond to the "selecting" an important word from among words contained in the existing text file.

Claims 7 and 8 go on to require the acquiring of associated information that is related to the important words selected in the selecting step that the outstanding Office Action attempts to equate to the teachings of column 12, lines 36-59 and a rationale that "acquiring" reads on "access the document." However, this step requires "acquiring said associated information related to said important word selected in selecting step," not simply accessing a document.

Furthermore, the rationale as to the subject matter of Claims 7 and 8 appears to attempt to equate the claimed "associated information" with the disclosure of the trackable nature of the system which can use frequency and recency of access. However, if this information is to be used in searching, the extracting of attribute information and important words would appear to be superfluous. Even assuming that a database could be constructed using the search for the popularity metric of frequency and recency of access, the manner that the detecting the occurrence of said event is being read on access, as at page 6 of the outstanding Office Action, is not clear. In this regard, this

event has already been read on the receiving of the key word query input of Claim 59 of Adar on page 5 of the outstanding Office Action. Accessing and receiving are clearly not the same events. Accordingly, the improper cobbling together of unrelated teachings is clear as is the lack of any suggestion in Adar that these unrelated events can be combined.

Moreover, searching the database constructed in the database constructing step for associated information corresponding to said key word detected in the key word detecting step would not be met if a search was being conducted based upon the previously relied upon frequency and recency of access.

While the page numbers in the outstanding Office Action may have changed, the improper reliance on the noted isolated teaching of Adar remains the same. The failure of the present outstanding Action to address any motivation to be found in Adar as to bringing these isolated and unrelated disclosures and claim limitations together also has not changed. Accordingly, this rejection is again traversed.

The outstanding Action further misconstrues the reasonable teachings of Adar from the bottom of page 4 to the top of page 5 of the outstanding Action. In this regard, Claim 1 recites that the information processing apparatus must display the “associated information corresponding to a present event,” and the outstanding Action begins by equating the “event” to reception of “a keyword query input.” However, as limitations are added by Claim 1, the interpretation of this “event” changes in a clear hindsight attempt to find pieces of isolated disclosure in Adar to manipulate into these added limitations. Thus, the originally interpreted present “event” changes from the originally asserted user “keyword input query” to “access” historical monitoring data in the explanation.

As if this initial flip flopping as to the “event” taught by Adar to be the claimed “present event” were not bad enough, the outstanding Action then ignores the claimed requirement that the search means must search “existing information having similarity to

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information corresponding to the present event detected by the event occurrence detection means” by returning to keyword entry disclosure (at col. 7, line 65-col. 8 line 1). However, this “keyword” entry is based on user direct input and is for searching book marks in the first instance, and has nothing to do with the database 120 monitoring of frequency of access noted at col. 12, lines 35-56.

Similarly, the attempt to read the display control taught at col. 15, lines 24-44 of Adar on the Claim 1 “display control means for controlling displaying of said associated information related to the existing information retrieved by said search means” (emphasis added) is without merit. Col. 15, lines 24-44 of Adar relate to the display of documents that have been determined by relevance feedback and the database 120 as described at col. 14, lines 37-54 and the separate “key word” search noted there that is not the same search as the user input “key word” search noted at col. 7, line 65-col. 8, line 1.

Just as the analysis offered as to the reasonable teachings and fair suggestions of Adar is neither reasonable nor fair, neither is the analysis of the reason why the artisan would attempt to modify the Adar bookmark based search engine with the Gottzman disclosed mobile shopping system. In this regard, and as noted by the court in In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (citing In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998)) the question is not just why the artisan would combine reference teachings, there also must be a reasonable explanation of why the artisan would even select the references for combination in the first place. This is particularly relevant as no clear linkage appears as to the Adar bookmark based search engine and the Gottzman system.

Furthermore, the reasons offered in support of the combination at page 5 of the outstanding Action defy logic because the “better business opportunities” are not explained

in terms of improving the Adar bookmark based search engine. The situation here is not unlike the presentation of unfounded conclusions lacking any concrete basis in the record that the Lee court noted at 61 USPQ2d 1435 as follows:

The examiner's conclusory statements [...] do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.

Consequently, it is clear that Claim 1, as well as Claims 2-6 and 17-20 that depend on Claim 1, all clearly define over anything fairly taught or suggested by Adar and/or Gottzman taken alone or together in any proper combination. Thus the rejection of these claims based upon these two references is traversed.

In addition, dependent Claims 2-6 and 17-20 each set forth further features that are clearly not taught or suggested by Adar and/or Gottzman taken alone or together in any proper combination. Accordingly, dependent Claims 2-6 and 17-20 and should be considered to be patentable over Claims 2-6 and 17-20 for this reason as well.

With further regard to independent Claims 9, 15, and 16, the above-noted arguments as to the improper combining of isolated teachings from different isolated portions of Adar and from Gottzman all without establishment of concrete and reasonable evidence as to motivation, is again believed to be relevant. It is also noted that the "searching" required in these claims is now specifically stated to be a search for associated information made by searching a database "for a previously processed existing file." Neither Adar nor Gottzman teach or suggest this search "for a previously processed existing file."

Consequently, it is clear that independent Claims 9, 15, and 16 all define over anything fairly taught or reasonably suggested by Adar and/or Gottzman taken alone or

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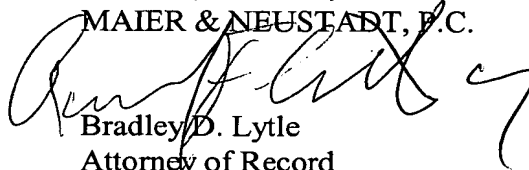
together in any proper combination. Thus, the rejection of Claims 9, 15, and 16 based upon these two references is also traversed.

As Claims 10-14 depend upon Claim 9, these claims should be considered patentable over anything fairly taught or reasonably suggested by Adar and/or Gottzman taken alone or together in any proper combination for the same reasons that independent Claim 9 is. In addition, each of these claims set forth further features that are clearly not taught or suggested by Adar and/or Gottzman taken alone or together in any proper combination and should be considered patentable for this reason as well. Thus, the obviousness rejection applied to Claims 10-14 is also traversed.

As no other issues are believed to remain outstanding relative to this application, it is believed that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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